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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/587,092 | 05/31/2000 | Steven R. Hoffman | VISAP026 | 6899 |

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EXAMINER

KANOF, PEDRO R

ART UNIT PAPER NUMBER

3628

DATE MAILED: 09/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

NF

| | | | |
|------------------------------|-----------------|----------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/587,092 | HOFFMAN ET AL. | |
| | Examiner | Art Unit | |
| | Pedro Kanof | 3628 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 6/5/03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. This correspondence is in response to the amendments filed 6/5/03.
2. Claims 5 and 12 have been amended as requested.

Claim Objections

3. Claim 3 contains the trademark/trade name Europay-Mastercard-Visa. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a credit/debit card and, accordingly, the identification/description is indefinite.

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Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted or an application for a patent by another filled in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in sections 351(a) shall have the effects for purposes of the subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 12, 13, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Martineau (U.S. Patent No. 5,915,226).

Claim 1: Martineau discloses a smart card loading system for loading value over a telecommunications network onto a smart card, said smart card loading system comprising:

a mobile telephone handset in communication with said telecommunications network, said handset including a subscriber identification module, a card reader for communicating with a smart card, which is separate from the subscriber identification module of the mobile telephone handset, arranged to be inserted in said handset, and an input interface for indicating a value to be loaded onto said smart card, said handset

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being arranged to generate a request message to load said value onto said smart card (Col. 5, lines 18-54);

a gateway computer arranged to receive said request message from said handset over said telecommunications network and to retransmit said request message (Col. 3, lines 23-25, and col. 4, lines 16-61);

a funds issuer computer arranged to receive said request message and to debit a consumer account associated with said smart card (Col. 2, lines 1-5); and

an authentication computer arranged to receive said request message and to authenticate said smart card, whereby said smart card may be authorized to load said value (Col. 2, lines 1-20, col. 3, line 63-col. 4, line 15).

2. Martineau discloses a smart card loading system as recited in claim 1.

Martineau also discloses wherein said telecommunications network is a wireless network (Abstract, col. 1, lines 14-20, col. 19, line 39-col. 11, line 15, col. 12, lines 19-42, and col. 12, lines 34-48).

Claim 12: Martineau discloses a method of loading value over a telecommunications network onto a smart card, said method comprising receiving at a mobile telephone handset with a subscriber identification module a request from a user to load a value into a stored-value application of said smart card inserted in said handset; generating a funds request message which includes said value and an authorization certificate; sending said funds request message over said

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telecommunications network to a funds issuer computer arranged to authenticate said second application and to generate an authentication response certificate; receiving through the mobile telephone handset to the smart card a response message which includes said authentication response certificate; validating said authentication response certificate as was discussed above in claim 1. Martineau also discloses loading additional value into the smart card, and consequently, it is implying opening a second application on said smart card (Col. 6, line 4-29) in order to apply to additional transactions (i.e. recharging the smart card).

Claim 13: Martineau discloses a method as recited in claim 12. Martineau also discloses wherein said telecommunications network is a wireless network as was discussed above in claim 2.

Claim 15: Martineau discloses a method as recited in claim 12. Martineau also discloses generating a transaction certificate to be used for irreputation (Col. 3, line 63-col. 4, line 61, col. 6, line 30-col. 7, line 22, col. 8, lines 59-62, col. 9, 54-58, col. 10, line 51-col. 11, line 7, and col. 13, line 34-col. 14, line 17).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be

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patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 9, 4, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martineau (U.S. Patent No. 5,915,226) in view of Baker et al. (U.S. Patent No. 5,884,292) and further view of Joao et al. (U.S. Patent No. 6,529,725).

Claim 9: Martineau discloses a method of loading value over a telecommunications network onto a smart card and transacting a purchase with said smart card, said method comprising receiving at a mobile telephone handset a request from a user to load a value onto said smart card inserted in said handset; generating a funds request message which includes said value (Col. 3, lines 23-43, col. 3, line 63-col. 4, line 38, and col. 5, line 42-col. 6, line 25); sending the load request message over the telecommunications network to an authentication computer arranged to authenticate the smart card; sending said funds request message over said telecommunications network to a funds issuer computer arranged to debit an account associated with said user and removing said smart card from said handset (Col. 2, lines 1-5).

However, Martineau does not disclose generating a load request message including a first cryptographic signature; receiving a response message which includes a second cryptographic signature and an approval to load; and validating said second

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cryptographic signature. Baker discloses smart card loading system (Abstract, fig.1, Col. 1, line 5-col. 2, line 23, col. 2, lines 62-67, col. 3, lines 22-45, col. 4, lines 15-20) including a first cryptographic signature; receiving a response message which includes a second cryptographic signature and an approval to load; and validating said second cryptographic signature (Col. 6, lines 11-59, col. 8, lines 33-46). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include these steps in the Martineau's system. One would have been motivated to use such steps in order to increase the system security.

However, neither Martineau nor Baker discloses placing said removed smart card in contact with a point-of-sale terminal to provide a contact interface with said point-of-sale terminal; and using said point-of-sale terminal to debit said smart card to perform a purchase. Joao discloses such steps in an invention that includes smart card and mobile telephone (Col. 12, line 66-col. 13, line 65, col. 14, lines 4-51, col. 15, lines 19-44, col. 15, line 54-col. 16, line 3, col. 16, line 57-col. 17, line 25, col. 19, line 8-col. 20, line 15). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include these steps in the Martineau-Baker system. One would have been motivated to use such steps in order to increase the system flexibility.

Claim 4: Martineau discloses a smart card loading system as recited in claim 1. Martineau and Baker disclose wherein said authentication computer

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authenticates said smart card using a first cryptographic signature and generates a second cryptographic signature to authenticate a load response, whereby said transaction is secured, as was discussed above in claim 9.

Claim 10: Martineau, Baker, and Joao disclose a method as recited in claim 9. Martineau also discloses wherein said telecommunications network is a wireless network as discussed above in claim 2.

8. Claims 5, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martineau (U.S. Patent No. 5,915,226) in view of Joao et al. (U.S. Patent No. 6,529,725)

Claim 5: Martineau discloses a smart card loading system for loading value over a telecommunications network onto a smart card, said smart card loading system comprising a mobile telephone handset in communication with said telecommunications network, said handset including a subscriber identification module, a card reader for communicating with a smart card, which is separate from the subscriber identification module of the mobile telephone handset, arranged to be inserted in said handset, and an input interface for indicating a value to be loaded onto said smart card, said handset being arranged to generate a funds request message which includes an authorization request certificate; a gateway computer arranged to receive said funds request message from said handset over said telecommunications network and to retransmit

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said funds request message; and a funds issuer computer arranged to receive said funds request message to authenticate said smart card using said authorization request certificate, and to generate an authentication response certificate for delivery to said smart card, whereby said smart card may validate said authorization request certificate through the mobile telephone handset and load said value, as was discussed above in claim 1. Martineau does not explicitly disclose wherein the smart card is able to be removed from the handset to interface with a point-of-sale terminal through a contact interface with the point-of-sale terminal. Joao discloses such steps as was discussed above in claim 9. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include these steps in the Martineau's system. One would have been motivated to use such steps in order to increase the system flexibility.

Claim 6: Martineau and Joao disclose a smart card loading system as recited in claim 5. Martineau also discloses wherein said telecommunications network is a wireless network as discussed above in claim 2.

Claim 8: Martineau and Joao discloses a smart card loading system. as recited in claim 5. Martineau also discloses wherein in response to a successful load, said handset is arranged to generate a transaction certificate to be used for irrepudiation (Col. 3, line 63-col. 4, line 61, col. 6, line 30-col. 7, line 22, col. 8, lines 59-62, col. 9, 54-58, col. 10, line 51-col. 11, line 7, and col. 13, line 34-col. 14, line 17).

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9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martineau (U.S. Patent No. 5,915,226) in view of Joao et al. (U.S. Patent No. 6,529,725) and further view of Heinonen et al. (U.S. Patent No. 5,887,266).

Claim 7: Martineau and Joao a smart card loading system as recited in claim 6. However, neither Martineau nor Joao discloses wherein said funds request message is integrated with the Short Message Service (SMS) channel of said telecommunications network. Heinonen discloses such as a step (Col. 1, lines 49-56, col. 8, lines 12-42, and col. 9, lines 50-64). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use such a step in the Martineau-Joao system. One would have been motivated to including this step in order to increase the security of the communication.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martineau (U.S. Patent No. 5,915,226) in view of Baker et al. (U.S. Patent No. 5,884,292) and further view of Joao et al. (U.S. Patent No. 6,529,725), and further view of Heinonen et al. (U.S. Patent No. 5,887,266).

Claim 11: Martineau, Baker, and Joao disclose a method as recited in claim 10. However, the references does not disclose wherein said messages are integrated with the Short Message Service (SMS) channel of said telecommunications network. Heinonen discloses such as a step as was discussed above in claim 7. Therefore, it

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would have been obvious to one having ordinary skill in the art at the time the invention was made to use such a step in the Martineau-Baker-Joao system. One would have been motivated to including this step in order to increase the security of the communication.

11. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martineau (U.S. Patent No. 5,915,226) in view of Heinonen et al. (U.S. Patent No. 5,887,266).

Claim 14: Martineau discloses a method as recited in claim 13. Martineau does not explicitly disclose wherein said messages are integrated with the Short Message Service (SMS) channel of said telecommunications network. Heinonen discloses such as a step as was discussed above in claim 7. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use such a step in the Martineau's system. One would have been motivated to including this step in order to increase the security of the communication.

12. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martineau (U.S. Patent No. 5,915,226) in view of Lucero. (U.S. Patent No. 5,559,312).

Martineau discloses a smart card loading system as recited in claim 2. However, Martineau does not disclose wherein the card reader is a Europay-Mastercard-Visa

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type card reader. Lucero discloses such as a step (Abstract). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a Europay-Mastercard-Visa type card reader in the Martineau's system. One would have been motivated to including this step in order to increase the flexibility of the system.

Response to Arguments

13. Applicant's arguments with respect to claim have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro R. Kanof, whose telephone number is (703)308-9552. The examiner can normally be reached on weekdays from 8:00 AM-5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough, can be reached on (703)308-0505.

15. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-1113.

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Any response to this action should be mail to: Commissioner of Patents and Trademarks c/o Technology Center 3600, Washington, D.C. 20231, or faxed to: (703) 305-7687, (for formal communications intended for entry) or: (703) 308-3961 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

PRK-9/16/03.


HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600